

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL L. MOHAN

Appeal No. 1996-3495
Application No. 08/321,941¹

HEARD: October 20, 1999

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS
and GONZALES, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 18. No other claims are pending in the application.

¹ Application for patent filed October 12, 1994.

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The invention disclosed in appellant's application relates to an electronic tracking system having a portable miniaturized geographic position determination and communications module (500) and a portable locating unit (300) located remotely from the module. The module comprises a global positioning satellite (GPS) receiver (520) for receiving a signal relating to the module's geographic position from a GPS system. The module further includes a communications transceiver (540) for transmitting the module's geographic position to the portable locating unit (300) to inform a user of the module's geographic position. Claims 1 through 8 are directed to the miniaturized geographic position determination and communication module per se, and claims 9 through 18 are directed to the combination of the miniaturized module and the portable locating unit.

A copy of the appealed claims is appended to appellant's brief.

The following references are relied upon by the examiner in support of his rejections of the appealed claims:

Durboraw, III (Durboraw)	5,266,958	Nov.
30, 1993		

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of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline
Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988).

Accordingly, we will initially direct our attention to the term "miniaturized" in the appealed claims. This word is a term of degree. Thus, there must be some standard or guideline for measuring that degree when the claim language is read in light of the specification as required in Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

Appellant's specification (see pages 3 and 5) makes it clear that the module containing the GPS receiver is required to be small enough to be hidden or concealed on a person's body or, in appellant's words, "concealment on the person" (specification, page 3) (e.g., less than 10 cubic inches as recited in original claim 13, "on the order of two inches square, more or less, with a thickness of one-half inch, more or less" (specification, page 7)). Thus, when read in light of the specification, the recitation that the module is

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"miniaturized" requires the module to be small enough to be concealable on a person's body as in the dimensional range noted supra.

The Eberwine patent does not expressly disclose any particular size for the module (1) containing the GPS receiver. Although it would be expected that Eberwine's module is relatively small because of space constraints in an aircraft (note column 6, lines 9-10 of the Eberwine specification), there nevertheless is no disclosure, express or inherent, that Eberwine's module is so small as to be concealable on a person's body or, more particularly, "readily concealable" (claim 9, line 3; specification, page 5) as required in appellant's invention.

Furthermore, we agree with appellant that a description in Eberwine's specification (see column 6, line 55) that the locating unit may be "mobile" does not necessarily mean that the unit is also "portable" as required in independent claim 9. According to Webster's Third New International Dictionary (G. & C. Merriam Company, 1971), the word "portable" is defined as being "capable of being carried: easily or conveniently

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transported." According to the same dictionary source, the word "mobile" merely means "capable of moving or being moved from one place to another." The terms "portable" and "mobile" therefore are not synonymous.

Based on the foregoing analysis of the Eberwine patent, we cannot agree that this reference expressly or inherently discloses each and every element of appealed claim 9. Accordingly, Eberwine does not anticipate the subject matter of claim 9 and, hence, the subject matter of claims 10 and 11, which depend from claim 9. We therefore must reverse the § 102(e) rejection of claims 9 through 11. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997), In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994), and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984) (For a reference to be properly anticipatory, each and every element of the rejected claim must be found either expressly or inherently in the applied reference.).

With regard to the § 103 rejection, the examiner concludes that the teachings of Durboraw would have made it obvious to package Eberwine's position determination and

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communication module "in a small enclosure to save space and weight" (answer, page 5). We also cannot sustain this rejection.

The relevant inquiry under § 103 is whether there is a reason, suggestion or motivation in the prior art that would have led one of ordinary skill in the art to combine the references in a manner to meet the terms of the claims. See e.g., In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-1532 (Fed. Cir. 1988).

In the present case, Eberwine does not expressly disclose the size of his geographic position determination and communication module 1, although it is expected that Eberwine's module is relatively small because of space constraints in an aircraft as discussed supra. Durborow, on the other hand, merely discloses a geographic position determination module that is small enough to be portable and to be hand-held.

There is no teaching in the first instance that Durborow's module is any smaller than the size of the module which one skilled in the art would expect to find in Eberwine's aircraft to warrant the substitution of Durborow's

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modular enclosure in Eberwine's system for the purpose stated by the examiner on page 5 of the answer. Furthermore, even assuming for the sake of argument that the size of Durborow's module were substituted for that of Eberwine's module, there is no teaching or suggestion in either reference that the resulting size would be small enough to be considered as being "miniaturized" to the extent that appellant's module is miniaturized when read in light of appellant's specification.

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The examiner's decision to reject claims 9 through 11
under § 102(e) and to reject claims 1 through 8 and 12 through
18 under § 103 is therefore reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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